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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

PEKKA J. HEINONEN

Serial No.: 09/503,362

Filed: February 14, 2000

For: Wireless Application Protocol  
Television

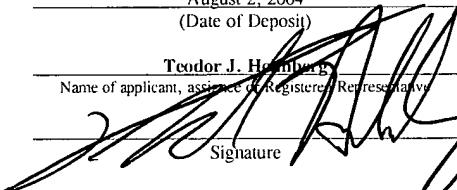
Examiner: Senfi, B. M.

Group Art: 2613

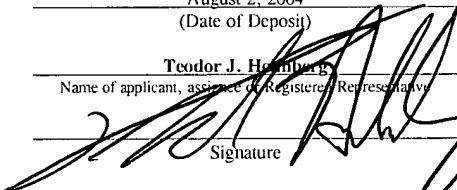
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Teodor J. Henningsen  
Name of applicant, assignee or Registered Representative



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### **APPEAL BRIEF**

SIR:

On May 3, 2004, appellant appealed from the final rejection of Claims 1-19. This is appellant's brief in accordance with 37 C.F.R. §1.192. This Appeal Brief is being submitted in triplicate with a check for \$330 in filing fee, as well as a check for \$110 for a one-month extension of time. If there is no or insufficient payment enclosed, those and any additional charges may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

The sections below are numbered in accordance with §1.192(c).

#### **(1) Real Party in Interest:**

The real party of interest herein is Nokia Corporation, Keilalahdentie 4, Espoo, Finland, FIN-02150.

#### **(2) Related Appeals and Interferences:**

There are no related appeals and/or interferences of which appellant is aware.

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**(3) Status of Claims:**

The application was filed with Claims 1-13, of which Claims 1 and 8 were in independent form. Claims 1, 8, and 10 were amended, and Claims 14-19 were added (Claims 14-15 being in independent form), in an Amendment dated December 3, 2003. No further additions or amendments were made after the December 3, 2003 Amendment; thus, Claims 1-19 are pending, with Claims 1, 8, 14, and 15 being in independent form.

**(4) Status of Amendments:**

There was no amendment filed subsequent to the final rejection.

**(5) Summary of Invention:**

The invention claimed in independent Claim 1 is a data processing system comprised of a mobile terminal (e.g., mobile terminal 12 in FIG. 2), an output device (e.g., TV monitor 24 in FIG. 2), and an interface module (e.g., interface module 22 in FIG. 2) connected to the data bus of the mobile terminal. The interface module takes data from the mobile terminal and converts the data so that it can be output on the output device (see lines 5-11, page 4).

The interface module comprises a protocol stack (e.g., WAP Protocol Stack 28 and/or SMTP Protocol Stack 28' in FIG. 2), a user agent (e.g., User agent 30 in FIG. 2), and a signal generator (e.g., TV Signal Generator 32 in FIG. 2). The protocol stack receives and then processes data received from the data bus of the mobile terminal before forwarding the processed data to the user agent, which decodes the processed data (see line 28, page 7, to line 4, page 8, and lines 6-8, page 9). Finally, the signal generator receives the decoded data and converts the decoded data into a format appropriate for the output device "so that the output device presents at least one of audio, video, and textual information to the user" (see lines 2-4, page 8, and lines 9-11, page 9).

The invention claimed in independent Claim 8 is a method of presenting data transmitted to and from a data bus of a mobile terminal using an interface module. In the first step of the claimed method, data from the mobile terminal is processed in accordance with at least one communication protocol (see lines 6-8 and 20, page 9). In the second step of the claimed method, the processed data is decoded and outputted by a user agent (see lines 8-9 and 20-21, page 9). In the third step, the

decoded data is converted into signals for presentation by an output device (see lines 9-10, page 9, and line 20, page 9, to line 1, page 10). In the fourth step, information is presented on the output device based on the signals from the third step (see lines 9-10, page 9, and line 20, page 9, to line 1, page 10).

The inventions claimed in independent Claims 14 and 15 are similar to the inventions claimed in independent Claims 1 and 8; however, independent Claims 14 and 15 explicitly recite that the output device has "a large screen relative to [the screen] of the mobile terminal".

**(6) Issues:**

**First:** Has there been a sufficient finding of inherency in the 35 U.S.C. §102(e) anticipation rejection?

**Second:** Is the subject matter of any of Claims 1, 8, 14 or 15 anticipated under 35 U.S.C. §102(e) by *Gershman et al.* (U.S. Pat. No. 6,401,085)?

**(7) Grouping of Claims:**

Claims 1-19 are grouped together for the first issue.

Claims 1-13 and 16-17 are grouped together for the second issue, as are Claims 14-15 and 18-19.

**(8) Arguments:**

**First Issue:** Has there been a sufficient finding of inherency in the 35 U.S.C. §102(e) anticipation rejection?

Concerning this issue, the prosecution record speaks for itself. The application was filed on February 14, 2000, with Claims 1-13, of which Claims 1 and 8 were in independent form. On September 4, 2003, an Office Action was mailed out, in which all thirteen pending claims were rejected under 35 U.S.C. §102(e) as anticipated by *Gershman et al.* (U.S. Pat. No. 6,401,085). In response, applicant filed an Amendment on December 3, 2003, in which Claims 1 and 8 were

amended to correct antecedent basis and Claims 14-19 were added. In the argument section, the following was stated in response to the Examiner's anticipation rejection:

In the Office Action dated September 4, 2003, the Examiner rejected all pending claims under 35 U.S.C. §102(e) as anticipated by *Gershman et al.* (US 6,401,085; hereinafter **Gershman**). Applicant respectfully disagrees.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "arranged as in the claim" (*Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)). Thus, even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present.

In the Examiner's anticipation rejection of Claims 1 and 8, the Examiner cites disparate and unconnected elements described in **Gershman** and, on this basis, alleges that **Gershman** teaches the arrangement of elements recited in Claims 1 and 8. However, the elements cited by the Examiner are not arranged in the same manner as the elements in Claims 1 and 8. Indeed, some of the elements cited in **Gershman** by the Examiner appear to have no relationship to each other at all. ....

...  
Moreover, the "interface module" recited in Claim 1 of the present application is comprised of three elements: (1) a "protocol stack", (2) a "user agent", and (3) a "signal generator". It is difficult to tell what the Examiner is citing in **Gershman** as teaching the protocol stack of Claim 1. Regardless, there is *no* "protocol stack" inside an "interface module", as required by Claim 1, in **Gershman**. Similarly, there is *no* "user agent" *nor* "signal generator" which comprise an "interface module", as recited in Claim 1, described in **Gershman**. More importantly, even if these three components were described in **Gershman** (and they are not), the Examiner would still have to show that the three components (i.e., the protocol stack, the user agent, and the signal generator) are described in **Gershman as parts of** "an interface module", as is recited in Claim 1. But this is impossible: there is no "interface module" comprised of a protocol stack, a user agent, and a signal generator described in **Gershman**.<sup>1</sup>

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<sup>1</sup> This passage only shows one argument from the various arguments put forth in the December 3, 2003 Amendment. It is believed that this argument and the Examiner's reply thereto provide the clearest example of the insufficiency of the §102 anticipation rejection.

In reply to the December 3, 2003 Amendment, the Examiner issued a Final Rejection on February 25, 2004, in which the §102 anticipation rejection was maintained (and also applied to new Claims 14-19). The Examiner's response in the Final Rejection to applicant's arguments reproduced above is reproduced verbatim below:

Applicant arguments (paper no. 6, page 9, lines 10+), that there is "no protocol stack" in side an "interface module" of Gershman '085 and "user agent" and "signal generator". Examiner respectfully disagrees. Gershman '085 (figs. 1 and 17) shows different terminals/access devices (PDA, Vehicle, Laptop, Telephone, Television and etc), that are using different protocol and communication/interface module 134 which inherently stack protocol for wireless communication with the terminals through the wireless network, and a "user agent" and "signal generator" is inherent and necessitated by the system of Gershman '085, in order for decoding the received data and converting the data into a signal to output and present the information to the user.

Applicant's attorney felt that this response was insufficient and called the Examiner several times to request a telephone interview to discuss the matter in order that an Appeal be avoided. Applicant's attorney was told that, in order to have an interview, an agenda for the telephone interview should be sent to the Examiner. On March 23, 2004, an agenda for the telephone interview was faxed to the Examiner. In the agenda, the above passages were reproduced and the following assertion was made:

To the extent that the Examiner's "response" can be understood, the Examiner appears to be arguing that an interface module comprised of a protocol stack, a user agent, and a signal generator, is necessarily inherent in *Gershman et al.* However, the Examiner's explanation of how these elements are inherent is difficult to understand and lacks any specifics. Furthermore, to the extent that the Examiner's reasoning is understood, it is completely insufficient for a finding of inherency. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). It is

respectfully submitted that the Examiner's paragraph above is not sufficient to establish inherency.

On March 29, 2004, the Examiner left a message with applicant's attorney stating that the Supervisory Patent Examiner (SPE) would be calling applicant's attorney to discuss scheduling the telephone interview. After repeated telephone calls to both the Examiner and the SPE, the SPE finally called the applicant's attorney on April 21, 2004. Notes taken by the applicant's attorney contemporaneously with the April 21, 2004 teleconference are reproduced below:

In this telephone call, the SPE first stated that he supported the Examiner's rejection and that, unless I could state a good reason otherwise, he would refuse to grant a formal telephone interview. I responded that, as indicated in a telephone interview agenda I faxed to them on 23 March 2004, the Examiner's anticipation rejection based on the *Gershman et al.* reference was unsupported and insufficient. The SPE responded that it looked sufficient to him. I then pointed out that we claim, as an element, an interface module comprising a protocol stack, a user agent, and a signal generator, and that such an interface module can not be found, either inherently or expressly, in *Gershman et al.* The SPE responded that, although a protocol stack is never mentioned in *Gershman et al.*, it necessarily must exist because all protocols must have a protocol stack, and protocols such as TCP/IP are discussed in *Gershman et al.* The mere existence of a protocol stack does not teach the interface module recited in Claim 1 of our application, as I pointed out to the SPE. The SPE repeated that he felt the anticipation rejection was sufficient, and that he would not grant a formal telephone interview.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In this case, the Examiner has not provided a basis in either fact or technical reasoning to reasonably support the determination that an interface module comprised of a protocol stack, a user agent, and a signal generator necessarily flows from the teachings of *Gershman et al.*

It is respectfully submitted that the prosecution record does not provide an adequate basis for a finding that the interface module comprising a protocol stack, user agent, and signal generator

as recited in the claims of the present application is inherent in the *Gershman et al.* reference. Withdrawal of the §102 rejection is respectfully requested.

**Second Issue:** Is the subject matter of any of Claims 1, 8, 14 or 15 anticipated under 35 U.S.C. §102(e) by *Gershman et al.* (U.S. Pat. No. 6,401,085)?

*Gershman et al.* discloses a system in which a "wireless phone or similar hand-held wireless device is combined with other peripherals to provide a portable portal into the Internet" (Abstract). A preferred embodiment of the invention claimed in *Gershman et al.* comprises a Mobile Portal Platform "including a Mobile Portal and an Electronic Valet" (col. 60, lines 52-53). The Mobile Portal comprises a Mobile Portal Server that is connected to various third party content and service providers through the Internet or a Mobile Portal Extranet (col. 60, lines 57-60). The Electronic Valet comprises a handheld wireless computer device with various sensors, such as GPS, bio-sensors, and environmental sensors, as well as recording equipment, such as a camera and an audio recorder, integrated into it (col. 60, lines 52-57).

Thin client software on the Electronic Valet in *Gershman et al.* allows the Electronic Valet "to execute many different software applications without the need for a large amount of internal memory and storage capacity" (col. 61, lines 1-3). In essence, the majority of processing for any software application takes place in the Mobile Portal Platform and related third party content and service providers rather than the Electronic Valet (col. 66, lines 63-66). In one embodiment, the Electronic Valet is a PDA equipped with GPS which provides a shopper with information concerning the stores nearest to the PDA. The Mobile Portal has a wireless connection with the PDA.

By contrast, independent Claims 1, 8, 14, and 15 of the present application recite a system and method in which a mobile terminal is connected to "an interface unit" which, in turn, is connected to an output device, such as a TV monitor. The interface unit receives, processes, decodes, and converts data received from the mobile terminal so that it may be reproduced by the output device (as video, audio, and/or textual information). As an example, an interface unit according to an embodiment of the present invention connected to a cellular telephone and a TV

monitor would allow the cellular telephone to transmit data to the interface unit which, in turn, would process and convert the data into signals capable of being shown on the TV monitor.

*Gershman et al.* does not disclose, either inherently or explicitly, the inventions claimed in any of independent Claims 1, 8, 14, and 15 of the present application. Specifically, *Gershman et al.* does not disclose, either inherently or explicitly, an interface module comprising a protocol stack for processing data to and from a mobile terminal, a user agent for decoding data to and from the protocol stack, and a signal generator for converting the decoded data into signals formatted for an output device, as is recited in independent Claims 1 and 14 of the present application. Furthermore, *Gershman et al.* does not disclose, either inherently or explicitly, an interface module performing the steps of (1) processing data received from a mobile terminal; (2) decoding, by a user agent, the processed data; and (3) converting the decoded data from the user agent into signals for presentation by an output device, as is recited in independent Claims 8 and 15 of the present application.

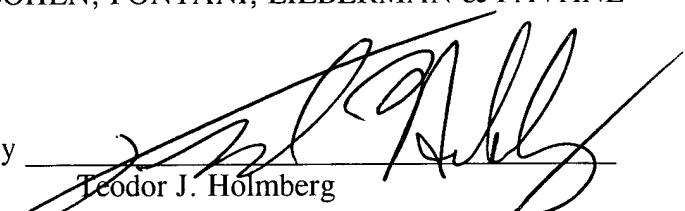
At least on the basis of the above, withdrawal of the rejection of independent Claims 1, 8, 14, and 15, as well as the claims depending thereon, is respectfully requested.

In conclusion, the final rejection should be reversed and Claims 1-19 allowed.

Respectfully submitted,

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Dated: August 2, 2004

**(9) Appendix:**

**This is a copy of the claims involved in this appeal:**

1. A system for the processing of data to and from a mobile terminal comprising:
  - a mobile terminal comprising a data bus for receiving and transmitting data to a wireless communication network;
  - an output device for presenting at least one of audio, video, and textual information to a user; and
  - an interface module connected to the data bus of the mobile terminal, the interface module comprising:
    - a protocol stack for processing data to and from the data bus of the mobile terminal in accordance with at least one communication protocol;
    - a user agent for decoding data to and from the protocol stack; and
    - a signal generator for converting the decoded data from the user agent into signals formatted for processing by the output device so that the output device presents at least one of audio, video, and textual information to the user based on the signals.
2. The system of claim 1, further comprising:
  - a user input device, manipulable by the user, for inputting data to the user agent for transmission through the mobile terminal.
3. The system of claim 1, wherein the protocol stack includes the Wireless Application Protocol.
4. The system of claim 3, wherein the protocol stack includes the Short Message Transport Protocol.
5. The system of claim 4, wherein the user agent is a Web browser.

6. The system of claim 5, wherein the browser is configured to interpret data in accordance with one of the Wireless Application Protocol and the Short Message Transport Protocol.

7. The system of claim 1, wherein the output device is a monitor.

8. A method of presenting data transmitted to and from a data bus of a mobile terminal using an interface module, comprising:

- (a) processing data from a data bus of the mobile terminal in accordance with at least one communication protocol;
- (b) decoding the processed data using a user agent and outputting the decoded data;
- (c) converting the decoded data from the user agent into signals for presentation by an output device; and
- (d) presenting information based on the signals by the output device.

9. The method of claim 8, wherein the output device presents the converted on a monitor display screen.

10. The method of claim 8, further comprising the step of:

- (e) receiving user input data by the user agent for transmission by the mobile terminal.

11. The method of claim 8, wherein the at least one communication protocol conforms to the Wireless Application Protocol.

12. The method of claim 8, wherein the at least one protocol conforms to the Short Message Transfer Protocol.

13. The method of claim 8, wherein the user agent is configured as a Web browser.

14. A system for transmitting data between a mobile terminal and an output device comprising:

- a mobile terminal comprising a screen and a data bus for receiving and transmitting data to a wireless communication network;
- an output device having a large screen relative to that of the mobile terminal for presenting at least one of audio, video, and textual information to a user; and
- an interface module connected to the data bus of the mobile terminal and to the output device, the interface module comprising:
  - a protocol stack for processing data to and from the data bus of the mobile terminal in accordance with at least one communication protocol;
  - a user agent for decoding data to and from the protocol stack; and
  - a signal generator for converting the decoded data from the user agent into signals formatted for processing by the output device so that the output device presents at least one of audio, video, and textual information to the user based on the signals.

15. A method of using an interface module to present data transmitted from a data bus of a mobile terminal on an output device having a large screen relative to that of the mobile terminal, comprising the steps of:

- processing data from a data bus of the mobile terminal in accordance with at least one communication protocol;
- decoding the processed data using a user agent and outputting the decoded data;
- converting the decoded data from the user agent into signals for presentation by an output device; and
- presenting information based on the signals by the output device.

16. The system of claim 1, wherein the output device comprises a television monitor.

17. The method of claim 8, wherein the output device comprises a television monitor.

18. The system of claim 14, wherein the output device comprises a television monitor.
19. The method of claim 15, wherein the output device comprises a television monitor.